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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,871	03/31/2004	Adam J. Ferrari	109878.141 US1	5569

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EXAMINER

VY, HUNG T

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,871

Applicant(s)

FERRARI ET AL.

Examiner

Hung T. Vy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :8/26/2004, 12/22/2004, 03/04/2005, 7/19/2004, 03/20/2006.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a search and navigation system for a set of materials, classified in class 707, subclass 3.
 - II. Claims 12-19, drawn to a method for navigating a set of materials, classified in class 707, subclass 102.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, unpatentabilities of the group I invention would not necessarily imply unpatentability of the group II invention, since the system of the group I invention could be use by other and materially different processes from those of the group II invention, for example, in the claim 13, group II, wherein revising the displayed rules and updating the displayed can be different the system in claims of group I.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Ann-Louise Kerner on 8/26/2006, a provisional election was made without traverse to prosecute the invention of group I, claim 1-11.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-19 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The Applicant should cancel claims 11-19.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

2. The specification has been checked to the extent necessary to determine the presence of possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 8/26/2004, 12/22/2004, 03/04/2005, 7/19/2004, 03/20/2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. However, the IDS filed on 8/26/2004 showed on page 1, has 3 pages but only one page in the recorded. The Applicant should correct.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the phrase "manipulating displayed content" renders the claim(s) indefinite because it is not clear what is displayed content. The claim is confusing, what is the displayed content? Is that the display content in the current Navigation when finished the searched or display content of rules.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-2 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces useful, concrete and tangible result. Mere ideas is the abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recites process must produce a useful, concrete. A system claim to pass muster, claim recites a system with hardware or hardware and software combination.

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With respect to claims 1-2 and 5, *a search and navigation system for a set of materials comprising* does not produce a useful, and concrete as set forth in 2106 (IV)(B)(2)(b)(ii), e.g., *a search and navigation system* but the claim recites nothing about hardware or hardware and software combination. Therefore, the claim is direct to non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-11 are rejected under 35 U. S. C. § 102 (b) as being anticipated by Yahoo!

[<http://web.archive.org/web/19991116151216/http://www4.yahoo.com/>].

With respect to claims 1-2, and best understood in claim 5, Yahoo ! is conventional navigation system discloses a search and navigation system for a set of materials comprising: a plurality of attributes characterizing the materials (as illustrated at page I of Yahoo discloses a plurality of attributes characterizing as art history, art weblogs, artist e.g....); a plurality of values describing the materials (as illustrated at page I of Yahoo discloses a plurality of values, for example art history has 1452 value describing the art history, the artists has 1975, e.g...), wherein each of the values (humanities) has an association with at least one of the attributes (art, e.g.) and each association defines an attribute- value pair (art/humanities, e.g.)(see exhibit I, II) ; a plurality of navigation states (selecting arts & humanities of Yahoo! Home page, Humanities and literature), wherein each navigation state corresponds to a particular expression of attribute-value pairs and to a particular subset of materials (for traversing, a conventional Web browsers is

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used such as internet explores, which provides a path from a category to a subcategory, Home/art → Art/Humanities and a path to sub subcategory Art/Humanities → Humanities/Literature (yahoo!, exhibits I, V & VI); a set of rules (the indication slot for set the rules that search the web or just this category)(see exhibit I); and an interface for providing a representation of a navigation state (see exhibits I, II, V and VI), for modifying one or more rules from the set of rules (selected search on the web (see exhibits I), a rules engine for specifying a set of rules for manipulating displayed content (the displayed content of searching the web or just this category) and for providing a representation of how modification of one or more rules affects the navigation state (representation by selected the web or just this category)(see exhibit I).

With respect to claims 3-4, Yahoo ! discloses a representation of how one or more rules were processed in reaching a current navigation state (representation by triggered the web or just this category)(see exhibit I).

With respect to claims 6-7, Yahoo ! discloses the interface further provides for modification of one or more rules associated with the current navigation state, provides for an addition of one or more rules associated with the current navigation state (one rules as the web or just this category associated with the current the arts state)(see exhibit I).

With respect to claim 8, Yahoo ! discloses the representation of one or more rules includes a representation of which of the one or more rules are activated (Exhibit I show the triggered on the web and this is activated as the web).

With respect to claim 9, Yahoo ! discloses the interface further provides for applying information from a current navigation state to the rules engine to specify one or more rules

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(Exhibit II shows that in the current navigation state (Directory > Arts > Humanities > Literature) and apply search on the web).

With respect to claim 10, Yahoo ! discloses displayed content (categories) and the representation of one or more rules associated (the web, just this category) with the current navigation state are combined (see Exhibit I).

8. Claims 1-11 is rejected under 35 U. S. C. § 102 (b) as being anticipated by Ferrari et al. (U.S. Pub. 2002/0051020).

With respect to claims 1-11, Ferrari et al. discloses a search and navigation system for a set of materials comprising: a plurality of attributes characterizing the materials (see paragraph 0047); a plurality of values describing the materials (see paragraph 0050), wherein each of the values (28) has an association with at least one of the attributes (22) and each association defines an attribute- value pair (see paragraph 0063); a plurality of navigation states (see paragraph 0064-0065 or see figs. 1-10 or see paragraph 0082+), wherein each navigation state corresponds to a particular expression of attribute-value pairs and to a particular subset of materials (see paragraph 0083); a set of rules (see paragraph 0067, 0077 or in fig. 22, in the navigation 400, the set of rules as bestsellers or love stories, e.g.); and an interface for providing a representation of a navigation state (for example 400), for modifying one or more rules from the set of rules (Bestseller, Love Stories. e.g.), a rules engine for specifying a set of rules for manipulating displayed content (the displayed content of searching Bestseller by selected the rules as Heat (ws/DD/5.1)) and for providing a representation of how modification of one or more rules affects the navigation state (representation by selected Bestseller, or Love Stories. e.g.), (see fig. 22).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yahoo! in view of Bennett et al. (U.S. Pub. 2002/0097088).

[<http://web.archive.org/web/19991116151216/http://www4.yahoo.com/>].

With respect to claim 11, Yahoo ! discloses all limitations of claimed invention recited in claim 1 except for the displayed content and representation of one or more rules with the current navigation state are split. However, Bennett et al. discloses the displayed content and representation of one or more rules with the current navigation state are split (see fig. 6 as Domain search and categories/segment are split). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Yahoo home page by adding the code to have split interface in order to improve a performance of location on the computer network for the stated purpose has been well known in the art as evidenced by teaching of Bennett et al. (see paragraph 0005).

Conclusion

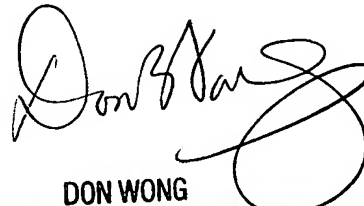
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hung T. Vy
Art Unit 2163
September 28, 2006.



DON WONG
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